

Application Serial No. 10/076,335
Supplemental Amendment A
Reply to Office Communication of June 16, 2005

REMARKS/ARGUMENTS

This paper is being submitted in response to the Office Communication dated June 16, 2005, having a shortened statutory period set to expire July 18, 2005 (July 16, 2005 being a Saturday), wherein:

Claims 1-20 were previously pending; and

Claims 1-20 were rejected.

Claims 1-5, 7-9, 11 and 12 have been amended herein, claims 6, 10, and 13-20 have been canceled without prejudice or disclaimer of the subject matter recited therein, and new claims 21-28 have been submitted for consideration. Accordingly, claims 1-5, 7-9, 11, 12, and 21-28 remain currently pending in the above-identified patent application. Applicants submit that no new matter has been added by this amendment and respectfully request reconsideration of all pending claims in light of the amendments and remarks made herein.

Restriction under 37 C.F.R. §1.145

In the present communication, the Examiner has indicated that Applicants' Amendment A, submitted for consideration on May 3, 2005 (hereinafter, "*Amendment A*") was non-responsive. Applicants respectfully traverse-in-part and in part overcome the Examiner's objections to *Amendment A* as follows. In *Amendment A*, Applicants attempted to clarify and augment the subject matter recited in originally-submitted claims 1-20 by canceling claims 1-20 and redrafting and amending the subject matter recited therein (as reflected in claims 21-38) in order to more clearly define and distinguish embodiments of Applicants' invention from the Examiner's cited reference, United States Patent No. 6,300,863 issued to Cotichini, (hereinafter, "*Cotichini*"). Applicants note that, in general, amendments to the claims may be made as of right "before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112" (see MPEP § 714) and further that specific provision is made within the Code of Federal Regulations and the Manual of Patent Examining Procedure for amendment via the cancellation of existing claims and the submission of new claims (see MPEP §714 and 37 C.F.R. §1.121).

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In the present Office Communication, the Examiner cites MPEP §821.03, indicating that Applicants' claim 21-38 are drawn to a non-elected invention and that therefore Applicants' *Amendment A* is non-responsive. More specifically, the Examiner has reproduced claims 1 and 21, indicating that the claims are "distinct" from one another. Applicants respectfully traverse the Examiner's objection as follows.

Section 821.03 of the Manual of Patent Examining Procedure includes a quotation of 37 C.F.R. §1.145 which states that, "If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144." As an initial matter, Applicants submit that notwithstanding the MPEP indications to the contrary, 37 C.F.R. §1.145 appears to be inapplicable, where, as in the present case, a potentially distinct group of claims supplants originally submitted claims rather than supplementing such original claims. Applicants will assume *arguendo* however, within this supplemental amendment that there is sufficient support in case law and legislative intent for an interpretation of 37 C.F.R. §1.145 which is applicable to the present situation.

If MPEP §821.03 is to be accepted for purposes of discussion, Applicants respectfully submit that it must be accepted *in toto*. Elsewhere MPEP §821.03 states that where the section is applicable, form paragraph 8.04 entitled, "Election by Original Presentation" should be utilized. Form paragraph 8.04 provides that once an applicant has received an action on the merits for originally presented claims, a constructive election of those original claims has been made and accordingly the applicant may be restricted to those claims under, for example, 37 C.F.R. §1.145. The substance of form paragraph 8.04 (as well as form paragraph 8.26 also found within MPEP §821.03) indicates however, as with all requirements for restriction, that the Examiner must provide reasons supporting a finding that the original and newly-added claims are independent or distinct. Applicants respectfully submit that the mere reproduction of multiple claims along with a conclusory statement that such claims are distinct from one another, is, without more, insufficient to support a restriction requirement (see MPEP §816). Applicants therefore submit that the Examiner's requirement for restriction by original presentation is improper.

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Notwithstanding the impropriety of the Examiner's requirement for restriction and consequently the objection to Applicants' Amendment A indicated in the present Office Communication, Applicants have endeavored to overcome the Examiner's objection via the amendments to originally presented claims 1-20 included herein. Applicants believe that the present supplemental amendment sufficiently remedies any omissions or errors in *Amendment A* as previously submitted. Should the Examiner harbor any existing or additional objections to the form and/or content of Applicants' submission however, Applicants hereby request that the Examiner contact Applicants' undersigned representative to schedule and conduct an Examiner interview teleconference at the first mutually agreeable time.

Claim Rejections under 35 U.S.C. § 102

In the Office Action dated March 24, 2005, claims 1-20 were rejected under 35 U.S.C. § 102(e) as being anticipated *Cotichini*. While not conceding that the Examiner's cited references qualify as prior art but in the interest of expediting prosecution, Applicants have elected to overcome the Examiner's rejections as follows. Applicants reserve the right, for example in a continuation application, to establish that one or more of the Examiner's cited reference do not qualify as prior art with respect to the invention embodiments claimed in the above-identified application.

In the present supplemental amendment, Applicants' claim 1 has been amended to recite, a method for determining a position of an electronic device within a wide area network, comprising, *inter alia*,

distributing a tracing tool to a first network element within said wide area network;
detecting a physical separation of said electronic device and an associated user... [and]
monitoring traffic on said wide area network utilizing said tracing tool, wherein said
monitoring comprises
intercepting data of said communication between said electronic device and said
second network element including said identifying indicia in response to
detecting said physical separation

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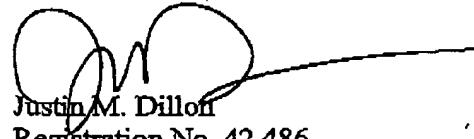
Applicants respectfully submit that the Examiner's cited portions of *Cotichini* fail to teach, show, or suggest the enumerated limitations of claim 1, as amended. Applicants' claims 9 and 24 each contain one or more elements or limitations substantively similar to those described with respect to claim 1. Accordingly, Applicants respectfully submit that claims 1, 9, and 24 and all remaining claims depending directly or indirectly therefrom are allowable in view of the references of record.

CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and request a Notice of Allowance thereof.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0447**.

Respectfully submitted,



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